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EXAMINER

TRETTEL, MICHAEL

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3673	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/660,433
Filing Date: September 07, 2000
Appellant(s): STEENBURG, KIP VAN

Richard B. Lazarus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 8, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 14-100 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The examiner notes that the applicant is correct in noting that no statement of rejection has been made concerning claims 1 to 13. This was an error on the part of the examiner, claims 1 to 13 should have been indicated as being allowed.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14 to 100 are rejected under 35 U.S.C. 251. This rejection is set forth in prior Office Action, Paper No. 11.

(11) *Response to Argument*

The applicant has essentially repeated his arguments presented earlier in the prosecution except in greater and more elaborate detail. This has essentially blurred the real issue at hand, which is whether the applicant is attempting to recapture subject matter added during the prosecution of the parent application in order to secure an allowance. The examiner offers the following comments and arguments in response.

The applicant is attempting to claim the supporting device without any reference to a longitudinal axis and a clamping device having an axis transverse to the longitudinal axis. These limitations were clearly added by amendment in response to the §102(b) rejection over the Klevstad reference. The applicant is now attempting to redefine these axes in broader terms, which terms are broader than the limitations expressly added during prosecution. The applicant is also attempting to drop out any reference to a clamping device that can simultaneously clamp and release the supporting device relative to the clamping device about the first and second (longitudinal and transverse) axes. Again, these limitations were expressly added during the prosecution of the 08/813708 application in order to define over the subject matter disclosed in the Klevstad patent, which was cited as being a §102(b) reference over certain of the claims.

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These inclusion of these limitations in the original claims 1 to 13 were also relied upon by the applicant as part of the arguments used to secure an allowance over the Klevstad patent.

Reference should be made to the arguments and statements made on pages 3 to 5 of the amendment of February 17, 1998 (Paper No. 4) of the 08/813,708 application.

Taking as an example claim 1 as amended in the 08/813,708 application, and the independent claims 14, 24, 48, 72, 81, and 91 the differences are as follows:

The claims drops out the specific reference to the abduction dimension and lithotomy dimension made by amendment in lines 2 and 3 of old claim 1:

The claims drop out the limitation of "having a longitudinal axis" in line 4 of old claim 1 which had been added by amendment:

The claims drop out the limitation "transverse to said longitudinal axis" added by amendment to line 8 of claim 1, and drops out any reference to the mounting device having a first axis:

The claims drop out "simultaneously" added by amendment to line 9 of claim 1:

The claims drops out the limitation added by amendment concerning to the support device being fixed in the clamping device against rotation about said longitudinal axis added to lines 11 to 13 of old claim 1, and now states that the support device is clamped against movement about the second plurality of axes;

The claims drop out the limitations added by amendment to lines 14 and 15 of claim 1 stating that the actuator device actuates the clamping device for simultaneously clamping the support device and mounting device, and now states that the clamping device can selectively clamp and release the support device relative to the mounting device.

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The independent claims therefore removes or broadens almost all the limitations added to old claim 1 during the prosecution in order to define over the Klevstad reference, these limitations were referred to and relied upon extensively in the applicant's arguments as defining over the Klevstad patent. Since these limitations were added in order to secure an allowance, any attempt to now drop them out altogether is an attempt at recapture. This is supported by the applicant's declaration, in which it is stated clearly that the mistake sought for correction was limiting claim 1 to a supporting device with a longitudinal axis and the clamping device having an axis transverse to the longitudinal axis. These limitations were added during the prosecution of claim 1 in the original application, and were not present in the claims as originally filed.

A similar analysis could be made with respect to the remaining independent claims, but it would simply become redundant. These claims are similar in breadth and scope to claim 14, and are sufficiently similar in terms of what has been amended that the arguments presented above also apply to them.

The Board is invited to consider the comments made by the examiner in pages 2 to 5 of the Final Rejection of May 21, 2002. The most relevant portion has been included in italics below:

Applicant's arguments filed on February 28, 2002 have been fully considered but they are not persuasive. The applicant has argued that the present Reissue Application and the claims therein are not an attempt at recapture, noting that while some limitations added during the parent application's prosecution have been deleted from the claims, other non-amended limitations have been deleted and yet other limitations added in order to make the claims both broader in some respects and narrower in other respects. This avoids the central issue present

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in this application, which is the applicant's deletion of the specific amendments added to the independent claim 1 in order to secure an allowance of the claims pending in the parent application. This is a textbook example of recapture, in support of his position the examiner will direct the attention of the Applicant to Pannu v. Storz Instruments Inc., 59 USPQ2D 1597 (CAFC 2001). The facts of the Pannu decision are quite applicable to the present application, since in the Pannu decision an attempt was made to remove limitations specifically added to the independent claims in order to secure an allowance. Removing claim limitations that were added by amendment is not an "error" that can be remedied by reissue.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Trettel
Primary Examiner
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MFT
May 13, 2003

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